

No. 2893.

United States
Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

Frank P. Snow, et al.,

Appellants,

vs.

Kellar-Thomason Company,

Appellee.

APPELLANTS' OPENING BRIEF.

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This is an appeal from an interlocutory decree by the United States District Court for the Southern District of California, granting an injunction restraining appellants from infringing a certain patent.

This case was tried in open court before the Hon. Wm. C. Van Fleet, sitting by special assignment.

In this brief the parties will be referred to as plaintiff and defendants.

The bill of complaint is in the usual form, alleging the grant and issuance of the patent in suit and its infringement by defendants.

The answer denies the patentable novelty of the alleged invention and denies infringement.

The patent in suit, No. 1,016,159, was granted on January 30, 1912, upon the alleged invention of a new and useful improvement in irrigating connection. The specification of the patent states:

“In irrigating systems pipes, such as vitrified pipes, are frequently used, and on the end of the pipe a gate or valve is placed to control the flow of the water through the pipe. These pipes are of a simple form and constructed in sections so that the end of one section fits into the mouth of the next section. For this reason the end of the pipe is perfectly plain and of cylindrical form and on this account is not well adapted for attaching a gate or valve constructed of metal.

“The object of this invention is to provide improved means for attaching a gate or valve to the end of such a pipe.”

It is thus seen that the object of the invention is not to provide a novel construction of an irrigating connection or gate or valve, but a novel or improved means for attaching a gate or valve to the pipe of the pipe line.

The first question is, “What is this improved means for attaching?” Plaintiff’s expert says, “The cementitious filler comprising the means to hold the gate on.” [Transcript, last line page 95, testimony Mr. Martin.]

It is not pretended by any of the witnesses on behalf of plaintiff that there was any invention in the particular construction of pipe or valve or gate. In fact, the patent in suit admits that “The specific construction of the gate is immaterial for the purpose of this invention, however, except that the invention is applicable to gates having a face plate 6 as described.”

The inventor, George E. Kellar, testifying on behalf of the plaintiff, admits that the gate shown in the patent is the gate which they had in use prior to the invention. He says: "But I conceived the idea of attaching that gate by means of flange and this cementitious filler." [Transcript page 31.] He admits that long prior to this he had been familiar with cement. He says:

"I knew the value of cement as a means of holding the two parts together, and I knew that by putting in—filling this space between the flange and pipe with this cementitious filler—I could hold the gate in place. That will hold to secure this flange to the end of the pipe. Now, that is the essence of the invention as I understand it." [Record page 31.]

"It is my understanding that the patent *merely* covers the means of attaching a valve or gate to the end of a pipe. *The other elements there were no novelty in.* The only novelty we claim in the combination is the cementitious filler, together with the flange, the flange and cementitious filler and that flange may be on either a gate or a valve." [Transcript page 35.]

As we shall see from the evidence, it is conceded by the witnesses on behalf of the complainant that there was no novelty in the flange. See, for example, testimony of Elmer O. Thomason, record page 42, where he says that the flange is similar in function to the flange of the ordinary bell and spigot joint on the pipe; it formed the annular space around the end of the pipe, just the same, and the cementitious filler was

used between the two identically the same way. The length or degree of flange is a matter of judgment. It was a matter of experiment when we started in with this width of flange. We do not need any other securing means beyond cement.

In this connection it should be noted that Mr. Thomason also testifies [Record page 39]: “Many years prior to this invention I knew of clay water pipes filled with cement between the flange and the end of the other pipe.”

Mr. Thomason says in regard to the invention of the patent in suit:

“The essential feature in this patent is the flange as a means of attaching the valve or gate to the end of a concrete pipe, or other kind of pipe; it might be vitrified, the flange allowing the annular space between the end of the pipe and the inside of this flange to be filled with a cementitious filler.” [Record page 37.]

From the testimony it is thus clearly deduced that plaintiff's theory is that the “invention,” if any, resides solely in the alleged discovery and demonstration that an iron valve could be secured to the end of a cement pipe without any anchors or bolts or clamps, or anything of that sort. [Testimony of Mr. Thomason, Record page 38.]

George C. Martin, manager of the plaintiff company, a lawyer, who testifies he has spent about sixteen years in the practice of patent law, says: “Now, the point is that the inventors who manufactured them did not, in fact, conceive that cement would hold as a *filler*

without some additional means until Mr. Kellar's invention." [Record page 9.]

The patent in suit, therefore, is not claimed to disclose the invention residing in any particular or novel construction of irrigating pipe or irrigating valve or irrigating gate. There is nothing in any of the details of construction of these parts which was new or novel, either alone or in combination with one another. This is also shown to be the fact by reference to the patent to Seitz, record pages 129-133.

Mr. Martin testifies that:

"The patent, therefore, simply covers the combination of a cementitious filler with a flange at the end of a pipe and the opening, and a convenient means of closing it. In other words, it has a means for attaching, and this cementitious substance has a means for attaching the valve and a gate where one—where the gate or valve ends the line." [Record page 46.]

It is proper to call attention at this point to the fact that although the drawings of the patent show and the specification describes the flange 15 as a part of the ring 12 and the casting 6 as a plate formed separate from the ring 12 and fastened thereto by bolts, rivets or "suitable fastening means"—in practice these are cast integral. What is termed the plate 6 merely forms the conventional seat for a slide valve. No novelty is claimed for or existed in this. The specification of the patent recognizes this and says:

"This gate 5 may be of any suitable construction comprising a face plate 6 having an opening 7 therethrough, around the edge of which a suitable

seat 8 is formed for the disk 9 of the gate. The specific construction of the gate is immaterial for the purpose of this invention, however, except that the invention *is applicable* to gates having a face plate 6 as described."

From the face of the patent, as well as from the testimony of plaintiff's witnesses, it is clear that any invention resided in the use of the "means" (a cementitious filler) to adhere to the surfaces of the flange of one part and the periphery of the other part and hold them in fixed relation to one another, at the same time making a water-tight joint. This "inventive thought," whether new or old, resided not in the particular form of the two pieces of pipe, pieces of irrigating system, or pipe and valve or gate, but in these "improved means for attaching" these two parts together, i. e., the cement filler.

That it was old and well known, long prior to Mr. Kellar's supposed invention, to join pieces of drain or sewer pipes together by means of a cementitious filler is shown by the patent to Jackson, number 927,353, dated July 6, 1909. [Record pages 134-136.] See lines 64-66 of Jackson's specification where he says the space between the bell or flange of one end of the pipe and the periphery of the other is filled with cement H and that this cement flows in around the spigot end of the pipe section "*to firmly hold the same in the socket.*"

The patent to Hassell, number 318,616, granted May 26th, 1885, refers to joints for pipes for water, gas, etc. [Record pages 112-113.] The flange B extends

over the periphery of the end of the adjoining pipe section and forms a recess in which the cementitious filler F', "of Portland or other cement," is cast and this ring or band or filler F' of Portland or other cement is the only thing which holds the two pipe sections together.

It would be amazingly strange that one skilled in such art should cast such a ring or filler F' of cement in between the surface of such flange and the surface of the periphery of the pipe section and not ascertain that such cement will adhere to the pipes and hold them together! Any user of Mr. Jackson's device must understand this and must ascertain it from the employment of his device. If not, why not? Is it because the Jackson patent does not describe how to compound the cement filler? Is it because the Jackson specification does not teach that such cement filler is to be of practically pure cement, mixed with water to only the consistency of putty? Is it for the reason that the Jackson specification does not state that the cement filler F' is not to be mixed in the proportions of one of cement and one of sand? If any of these be the failure of the Jackson disclosure, Mr. Kellar's disclosure will be found to fail in the same respects, as will be most specifically pointed out.

On pages 107 and 110 of the record appear extracts from the "International Library of Technology." Each of the drawings [page 110] illustrates joints between pipe sections made by a cementitious filler filled in between a flange and the periphery of a pipe section. If these descriptions and these showings of the joint and

filler are not sufficient, wherein do they fail? If "cement mortar mixed 1:1" will not hold the pieces together or will not give a water-tight connection, *what kind* of a cementitious filler will?

The Worley patent, number 969,320, granted September 6, 1910 [Record pages 137-139], absolutely depends upon the filler or luting of cement 18 to hold the metal collar or ring 1 and the concrete pipe 2 together and forms a water-tight joint between them. Mr. Worley certainly knew and recognized the cementing of these pieces together. He says [Record page 138, Worley's specification, column 2, lines 95-101] this "luting of cement is then applied around the collar and against the end of the pipe 2 *so as to cement the collar firmly in the pipe.*" This is identically the alleged action of the "cementitious" filler of the Kellar patent. Does Mr. Worley's patent fail as an anticipation because he does not more fully describe how to compound his luting or filler of cement? Is it because the workman must experiment and ascertain how to mix cement to make it so hold? If this is the reason, we shall see that the Kellar description is even more faulty and that if Mr. Kellar was the discoverer of how to so mix a filler of cement as to make it cement to pieces of iron or a piece of iron and a piece of concrete together, he has utterly failed to disclose how to do it, and he has failed to claim his discovery of how to do it.

The Worley patent disclosure differs from the Kellar solely in the formation of the gate or valve, and the Worley patent, as a franchise is directed to Mr. Wor-

ley's invention of a specific construction of gate valve. But he discloses the use of the cementitious filler for joining his gate valve to the end of the pipe by means of cementing it to the pipe.

Clearly these prior patents and publications show that the use of cement to join two metallic surfaces together, or to join a metallic surface and a concrete surface or object, was old and well known long prior to Mr. Kellar's alleged invention. Mr. Thomason, of the plaintiff company, says: "Many years prior to this invention I knew of clay water pipes filled with cement between the flange and the end of the other pipe." [Record page 39.]

The alleged inventor, Mr. Kellar [Record page 31], admits that he knew the value of cement as a means of holding the two parts together. Mr. Martin says that he has seen pipes that have been placed hundreds or thousands of years in fact with joints made with cement. He also positively states that cement itself is not new as a means for forming a closure between the bell and the spigot end of the pipe. [Record page 46.]

Mr. Martin says that the novelty of the patent in suit was the conception that cement would hold as a filler without additional means forming a mechanical holding device. [Record page 96.] This was not new. The patent to Hassell [Record page 113], the patent to Worley [Record page 137], the patent to Jackson [Record page 134], the patent to Wakefield [Record page 126], show examples of a cement filler alone re-

lied upon to make the joint and hold the two pieces in position with respect to each other.

The patent to Buttorff [Transcript pages 140-143] shows a headgate of the sliding type having the same species of flange and the same cement filler. This Buttorff patent as a franchise of monopoly is directed to improvements in the construction of the headgate itself and the invention is not directed towards means for fastening the headgate on the line. It is true Mr. Buttorff not only shows and describes the cement or concrete filler 27, but also bolts 24 extending between lugs 23 on the flange and lugs 25 on the pipe. It is obvious, however, that anyone having to disconnect a Buttorff headgate from a line would have it brought to his attention (a well known fact of common knowledge as proven by the other prior patents) that this cement filler would adhere to both these metal parts and must be chipped off in order to remove the gate. This Buttorff patent, taken in connection with the Worley patent, shows absolute want of invention, shows mere selection on the part of Mr. Kellar and proves conclusively that what Mr. Kellar did cannot rise to the dignity of "invention" as distinguished from mere mechanical skill and the use of the common knowledge of this art.

Clearly, the Kellar patent in suit cannot be sustained upon any theory of any difference between the cement filler referred to therein and the cement filler of the prior patents or of the "International Library of Technology" drawings and description. [Record pages 107-110.]

Particular attention is called to the fact that the Kellar patent does not in any manner describe or set forth the composition of this cementitious filler. It does not in any manner teach anyone how to compound or apply the same. On the contrary, the theory of the specification seems to be that *a* cementitious filler which will have the desired effect is old and well known in the art. If not, the patent is void for uncertainty, for the only references in the Kellar patent to this cementitious filler are in column 2, lines 66-72, and in the claim. All that is contained in the specification or description is that "with the pipe applied to the gate in this position I fill this annular space with a filler 16 of cement *or a similar composition* which is adapted to set and harden in place. After this cement 16 hardens the gate will be found to be securely fastened to the pipe, for the cement attaches itself to the outer surface of a pipe and the inner surface of the flange 15."

If the invention resided in any particular kind of a cement filler, "or a similar composition," it was the duty of the inventor, Mr. Kellar, under section 4888 of the Revised Statutes, to file in the patent office a "written description of the same and of the manner and process of making, constructing, compounding and using it, in such full, clear, concise and exact terms as to enable anyone skilled in the art or science to which it pertains, to make, construct, compound and use the same." If it resided in anything specific or particular, either in manner of mixing the filler or in the ingredients of the filler, it was necessary for these

to be pointed out and made a part of the "claim" of the patent under section 4888 of the Revised Statutes. Failing in this, the patent was void.

In re Incandescent Lamp Patent, 159 U. S. 465, 474;

Howard v. Detroit Stove Works, 150 U. S. 164;

Wood v. Underhill, 5 How. 1;

Tyler v. Boston, 7 Wall. 327;

Mitchell v. Tilghman, 19 Wall. 287;

Chemical Rubber Co. v. Raymond Rubber Co. (C. C.), 68 Fed. 570;

Badische Anilin & Soda Fabrik v. Kalle (C. C.), 94 Fed. 163;

Matheson v. Campbell, 78 Fed. 914;

Panzl v. Battle Island Paper Co., 138 Fed. 48.

The patent in suit is void for want of invention, for anticipation, and for indefiniteness and uncertainty both of specification and claims and the decree should, therefore, be reversed.

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